



Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q76879
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 10/634,847	Filed August 06, 2003
	First Named Inventor Masanori ONUMA	
	Art Unit 2839	Examiner Thanh Tam T. Le
	WASHINGTON OFFICE 23373 CUSTOMER NUMBER	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.		
This request is being filed with a notice of appeal		
The review is requested for the reason(s) stated on the attached sheet(s).		
Note: No more than five (5) pages may be provided.		
<input checked="" type="checkbox"/> I am an attorney or agent of record.		
Registration number <u>57,574</u>		
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<u>February 13, 2006</u> Date		

PRE-APPEAL BRIEF REQUEST FOR REVIEW
U.S. Appln. No. 10/634,847
Atty. Docket No. Q76879



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q76879

Masanori ONUMA, et al.

Appln. No.: 10/634,847

Group Art Unit: 2839

Confirmation No.: 6506

Examiner: Thanh Tam T. Le

Filed: August 6, 2003

For: METHOD OF CONNECTING WIRE AND TERMINAL FITTING

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MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated September 13, 2005, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

Claims 1-4 are all the claims pending in the application.

Claim Rejections

Claims 1-3

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swengel, Sr. et al. (U.S. Patent No. 3,656,092) in view of Applicant's submitted Prior Art (APA). Applicants respectfully traverse this rejection in view of the following arguments.

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Claim 1 recites *inter alia*:

“...inserting the electric wire into the insertion hole of the connecting member;
compressing the connecting member radially inwardly so as to caulk an inserted
portion of the electric wire uniformly over a whole periphery thereof; ...”

As seen from the above portion of claim 1, claim 1 clearly recites compressing the connecting member *so as to caulk an inserted portion of the electric wire*. In order for there to be an inserted portion of the wire, the wire must be inserted before the compressing. Thus, in the claimed invention, the wire is inserted and then an inserted portion of the wire is caulked by compressing the connecting member. Claim 1 is allowable over the combination of Swengel and the APA at least because these references fail to teach compressing as claimed. The Examiner asserts that Swengel column 2, lines 64-66 teaches compressing as claimed (*see* item 2 on page 2 of the Final Office Action dated September 13, 2005), but this alleged compressing is clearly deficient at least because the Swengel compressing does not relate to the alleged Swengel wire (electrical lead 10) and because the alleged Swengel compressing occurs before the wire 10 is even inserted into the alleged connecting member (sleeve 24).

The portion of Swengel cited by the Examiner (column 2, lines 64-66) teaches forging or crimping sleeves 22 and 24 to mechanically lock them. The Examiner asserts that sleeve 24 constitutes the claimed connecting member and that electrical lead 10 constitutes the claimed wire (*see* item 2, page 2 of the September 13 Office Action). As is clearly seen from the plain language of the cited portion of Swengel, the Swengel compressing is only related to the sleeves 22 and 24. The Swengel compressing does not even relate to the alleged wire 10. Because the

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Swengel compressing is not even related to the wire 10, it cannot be compressing so as to caulk an inserted portion of the wire as claimed.

Furthermore, the Examiner's alleged compressing occurs before the wire 10 is even inserted into the alleged connecting member 24. Accordingly, the Examiner's alleged compressing cannot be so as to caulk *an inserted portion of the wire*, because there is *no inserted portion of Swengel wire 10* when the alleged compressing occurs. Indeed, column 2, lines 64-66 of the Swengel patent discusses Fig. 1. As shown in Fig. 1, the sleeves 22 and 24 are mechanically locked by forging, crimping or the like (the Examiner's alleged compressing) when the wire has not yet even been inserted into the terminal 16, which includes sleeves 22 and 24. In fact, Fig. 1 is described as showing an electrical lead *positioned for insertion* (column 2, lines 24-26). Fig. 4 also shows that the sleeves 22, 24 are crimped or forged before the alleged wire 10 is even inserted into the terminal. Thus, the alleged wire 10 is not even inserted into the alleged connecting member 24 when the alleged compressing is performed. At least because the Swengel crimping occurs before there is even an inserted wire portion, the Swengel crimping cannot constitute the claimed compressing so as to caulk an inserted portion of the electric wire. Again, the Examiner's alleged compressing is the crimping or forging of two sleeves 22 and 24 is simply unrelated to the wire (electrical lead 10).

The Examiner cites the APA only for the teaching of ultrasonic welding, and the APA does not correct the above noted deficiencies of Swengel. Accordingly, Applicants submit that claim 1 is allowable over the combined teachings and suggestions of Swengel and the APA.

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Claims 2 and 3 depend from claim 1 and are therefore allowable at least because of their dependency.

Furthermore, claim 2 recites that the connecting member is compressed by rotary swaging. The Examiner asserts that the combination of Swengel and the APA disclose rotary swaging as claimed. However, prior art Figs. 7 and 8 of the present application (the APA) do not teach rotary swaging to compress a connecting member. Furthermore, Applicants can find no mention of rotary swaging in Swengel. Accordingly, compressing a connecting member by rotary swaging does not appear to be disclosed by the combination of Swengel and the APA as asserted by the Examiner, and Applicants submit that claim 2 is further allowable at least for this reason.

In view of the above, Applicants respectfully request that the rejection of claims 1-3 be reviewed and withdrawn.

Claim 4

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Swengel in view of the APA and further in view of Newman et al. Applicants respectfully traverse this rejection.

Claim 4 depends from claim 1. The Examiner uses Newman only for the feature of a clamping portion. Newman fails to correct the above-noted deficiencies of the combination of Swengel and the APA. Therefore, even if, for the sake of argument alone, the Examiner's assertions regarding Newman were correct, and one of ordinary skill in the art would have been motivated to modify Swengel and the APA with Newman, the combination would still be

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deficient with respect to claim 1 and its dependents. Accordingly, Applicants submit that claim 4 is allowable over the combination of Swengel, the APA and Newman.

Conclusion

In light of the above, Applicant respectfully requests that the rejections under 35 U.S.C. § 103 be withdrawn, and the application be passed to issue.

Respectfully submitted,



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